



# **I. IN THE CLAIMS**

## **A. Amendment of Claim 20**

Applicant hereby adopts the amendment to Claim 20 required by the Office Action mailed July 24, 2002 (hereinafter referred to as the "Office Action"). Namely, line 15 of Claim 20 is amended from "hand" to "hand; and". (Office Action, p. 2). In all other respects, Claim 20 remains unchanged.

## **B. Amendment of Claim 22**

Claim 22 is amended as described in Section II(B), below.

# **II. REMARKS**

This is a full and timely response to the outstanding Office Action mailed July 24, 2002. Claims 20-23 are pending. Each objection and rejection in the Office Action is discussed in the remarks that follow. Claim 20 is amended as described above. Claim 22 is amended as described in Section II(B), below. Applicant respectfully request that this Amendment and Request for Reconsideration be entered and considered.

## **A. Claim Objections**

Claim 20 is objected to as failing to follow formalities; namely, line 15's "hand;" should be changed to: "hand; and." According to the Office Action, this change would improve the claimed form to comply with "U.S. practice." (Office Action, p. 2).

In response to this objection, Applicant amends said claim as suggested by the Office Action, and as described above.

B. Claim Rejections Under 35 U.S.C. Section 112

Claim 22 has been rejected under 35 U.S.C. Section 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action asserts that Claim 22, when read with Claim 20, recites a roller ball at two locations (i.e., at the "upper left portion of the body" (Claim 20) and at the "upper right portion" of the device (Claim 22)). (Office Action, p. 2).

Applicant's intention with respect to Claim 22 is to claim the mirror image (i.e., a left-handed version) of the device of Claim 20, as described in Applicant's specification and his Figures. (See p. 12, lines 8-10; p. 14, lines 19-20 and Figures 3 and 4). Therefore, Applicant hereby makes whatever amendment to Claim 22 that is deemed necessary by the PTO to claim the "mirror image" of the device of Claim 20. Applicant specifically requests the PTO's guidance in accordance with Section 707.07(j) of the Manual of Patent Examining Procedure.

C. Claim Rejections Under 35 U.S.C. Section 103(a)

Claims 20, 21 and 23 were rejected under 35 U.S.C. Section 103(a) as being unpatentable over *Bidiville et al.* (U.S. Patent No. 5,578,817) (hereinafter referred to as "*Bidiville*") and further in view of *Jarlance-Huang* (U.S. Patent No. 5,668,574) (hereinafter referred to as "*Jarlance-Huang*"). Claim 22 has been

rejected under 35 U.S.C. Section 103(a) as being unpatentable over *Bidiville*, in view of *Jarlance-Huang*, as applied to Claim 20, and further in view of *Koh et al.* (U.S. Patent No. 5,122,654).

1. Claim 20

The elements of Claim 20 are summarized as follows: "[a] cursor control device for ergonomic hand-held or work surface use; including:" a "palm surface" which allows the ulnar fingers to wrap around the side of the body and under the body to hold the device in said hand; a "flat underside;" a "roller ball" which allows the ulnar fingers to wrap around the side of the body and under the body to hold the device in said hand;" "at least one key" which allows the ulnar fingers to wrap around the side of the body and under the body to hold the device in said hand; and a "communicator" between the device and the computer. (Claim 20).

a. Summary of the Office Action's Rejection of Claim 20

The Office Action rejects Claim 20 based on *Bidiville* and further in view of *Jarlance-Huang*. (Office Action, p. 3). The Office Action relies on *Bidiville*, which, in the Examiner's view, discloses the claimed invention except for the limitation "ulnar fingers wrapping around the side and under the device to hold the device in the user's hand." (Office Action, p. 3). To address this deficiency, the Office Action turns to *Jarlance-Huang* which, according to the Office Action, teaches the missing limitation. (Office Action, pp. 3 and 4).

For the numerous reasons state below, Applicant respectfully, but adamantly, disagrees with the rejection.

b. The Office Action Does Not Establish  
a *Prima Facie* Case Of Obviousness

For a rejection under Section 103, the PTO bears the initial duty of supplying a *prima facie* case of obviousness by a preponderance of the evidence. (See In re Oetiker, 977 F.2d 1443, 1449, 24 U.S.P.Q.2d 1443, 1447 (Fed. Cir. 1992)). "Even if obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." (See In re Kotzab, 217 F.3d 1365, 1370, 53 U.S.P.Q.2d 1313 (Fed.Cir. 2000)). Furthermore, "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." (Id.). Also, the obviousness analysis requires that the claimed invention be obvious at the time the prior art references were disclosed. (See In re Zurko, 258 F.3d 1379, 1383 (Fed.Cir. 2001)).

The Office Action does not establish a *prima facie* case of obviousness for numerous reasons. First, the Office Action asserts that *Bidiville's* "elevated upper housing" corresponds to the "convex palm surface" of the claimed invention. (Office Action, p. 3). This is absolutely incorrect. Applicant initially notes that this element as an "upper housing," not as an "*elevated* upper housing," as stated by the Office Action. (Office Action, p. 3). Nevertheless,

For the numerous reasons state below, Applicant respectfully, but adamantly, disagrees with the rejection.

b. The Office Action Does Not Establish  
a *Prima Facie* Case Of Obviousness

For a rejection under Section 103, the PTO bears the initial duty of supplying a *prima facie* case of obviousness by a preponderance of the evidence. (See In re Oetiker, 977 F.2d 1443, 1449, 24 U.S.P.Q.2d 1443, 1447 (Fed. Cir. 1992)). "Even if obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference." (See In re Kotzab, 217 F.3d 1365, 1370, 53 U.S.P.Q.2d 1313 (Fed.Cir. 2000)). Furthermore, "identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention." (Id.). Also, the obviousness analysis requires that the claimed invention be obvious at the time the prior art references were disclosed. (See In re Zurko, 258 F.3d 1379, 1383 (Fed.Cir. 2001)).

The Office Action does not establish a *prima facie* case of obviousness for numerous reasons. First, the Office Action asserts that *Bidiville's* "elevated upper housing" corresponds to the "convex palm surface" of the claimed invention. (Office Action, p. 3). This is absolutely incorrect. Applicant initially notes that this element as an "upper housing," not as an "*elevated* upper housing," as stated by the Office Action. (Office Action, p. 3). Nevertheless,

*Bidiville's* "upper housing" certainly does not "correspond" to Claim 20's "convex palm surface," as asserted by the Office Action. (Office Action, p. 3).

*Bidiville's* "upper housing" (*Bidiville*, numeral 2005) is at an angle of approximately 30-degrees; namely, *Bidiville's* "angled support cooperat[es] with the upper housing." (*Bidiville*, Col. 25, lines 1-6; figure 20D). With *Bidiville*, this, in turn, places the fingers and thumb in a "neutral posture," since the user rests his or her entire hand, including the ulnar fingers, on the "upper housing." (*Bidiville*, Col. 25, lines 1-11; figures 20A-B). (Note that with *Bidiville*, the user's first three fingers rest on the *Bidiville* buttons, which are flush with "angled support cooperating with the upper housing," (see *Bidiville*, figures 20A-B, numerals 2020A-C) and the last finger of the hand rests on the unoccupied space to the contiguous right of numeral 2020A. (See *Bidiville* figure 20B, *Bidiville's* "unoccupied space" being referred to by Applicant is unnumbered)).

However, with the device of the claimed invention, the "convex palm surface" has the ulnar fingers "wrapping around the side and under the device," instead of resting on top and instead of a "neutral position." (Claim 20). This difference is critical to the functionality of the claimed invention: having the ulnar fingers wrap around and under the device, as Claim 20 does, allows the user to hold the device of the claimed invention in the user's hand, so that the device can be used while being "hand-held." (Claim 20). Since, as described above, the ulnar fingers with *Bidiville* are on *Bidiville's* "upper housing," they cannot "wrap around the side and under the device." Therefore, the ulnar fingers cannot be used to hold the *Bidiville* device in the user's hand as claimed in Claim 20.

*Jarlance-Huang* is of no avail here because there is no teaching or motivation in *Bidiville* or *Jarlance-Huang* to use *Jarlance-Huang* to cure the *Bidiville* deficiency. (See In re Dembiczak, 175 F.3d 994, 1000-01, 50 U.S.P.Q.2d 1614, 1617-19 (Fed.Cir. 1999) (for an obviousness rejection to be sustained, the Federal Circuit requires the PTO to make specific findings as to the contents of the prior art which suggest the combination of the references)). Moreover, even if proper motivation was established, using *Jarlance-Huang* to cure the *Bidiville* deficiency would result in an impossible device because the ulnar fingers cannot simultaneously be on top – as is required by *Bidiville* – while also “wrapping around and under the device” – as is required by the fictitious device conjured by the Office Action.

Furthermore, using *Jarlance-Huang* to cure the *Bidiville* deficiency is entirely inconsistent with *Bidiville*. *Bidiville* seeks to (1) have the user's entire hand rest on the “upper housing,” (2) which naturally puts the hand in a pronated (i.e., spread) position, and (3) puts the fingers and thumb of the hand in a “neutral posture” (i.e., at a 30-degree angle). (*Bidiville*, Col. 25, lines 1-11; figures 20A-B). Using *Jarlance-Huang* to cure the *Bidiville* deficiency destroys these purposes: (1) the user's entire hand would not rest on the top of the device, (2) the hand would not be in a pronated or “spread” position, and (3) the hand would be in a clenched or grasping posture (to hold the device in the hand) instead of in *Bidiville*'s desired “neutral posture.” For these reasons, *Bidiville* leads one with ordinary skill in the art away from using *Jarlance-Huang* and away from the device of Claim 20. (See In re Spinnable, 405 F.2d 578, 587 (1969) (a

prior art reference that teaches away from, or discourages, the making of the claimed invention undermines *prima facie* obviousness.”)).

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness as to *Bidiville* or to using *Jarlance-Huang* to cure the *Bidiville* deficiency.

Additionally, contrary to the Office Action's assertion, *Bidiville's* ball (*Bidiville*, figure 20E, numeral 710) is not mounted “at the upper left portion of the body,” as in Claim 20. (Office Action, p. 3). Thus, *Bidiville's* “ball” does not correspond with the “roller ball” of Claim 20. The *Bidiville* ball is mounted at the lateral mid-point of the device, as shown in *Bidiville's* figures 20A, 20B and 20E. This is made clear by the fact that the *Bidiville* ball aligns the fingers of the user's hand, including the ulnar fingers, with the front of the device, to the *Bidiville* buttons. (See *Bidiville*, figures 20B and 20C).

Claim 20's ball, though, is at the “upper left portion of the body,” so that it aligns the user's ulnar fingers to the side of the device. (Claim 20, Figures 2-4 (emphasis added)). This difference between *Bidiville* and Claim 20 is critical since only aligning the ulnar fingers to the side of the device – as Claim 20 does - - allows the “ulnar fingers to wrap around the side and under the device” as claimed. (See Claim 20, Figures 2 and 4).

The *Bidiville* ball purposefully aligns the ulnar fingers to the front of the device so that they (1) maintain a “neutral posture” by resting on *Bidiville's* “angled support cooperating with the upper housing” and (2) are able to activate



the buttons which are at the front of the "upper housing." (*Bidiville*, figure 20B, numerals 2020A-C). This differs vastly from Claim 20. Also, using *Jarlance-Huang* to cure the *Bidiville* deficiency, as conjured by the Office Action, would destroy these purposes. Thus, a skilled artisan referring to *Bidiville*, would be led away from using *Jarlance-Huang* to cure the *Bidiville* deficiency as conjured by the Office Action and away from the path taken by Claim 20. (Applicant notes that it is obvious that the *Jarlance-Huang* ball is also not located at the "upper left portion of the body.") (*Jarlance-Huang*, figures 1 and 2, numeral 3)). For all these reasons, a *prima facie* case has not been established as to the obviousness of Claim 20. (See In re Sponnable, 405 F.2d at 587).

Also, very significantly, the Office Action fails to establish, as it must, that the using *Jarlance-Huang* to cure the *Bidiville* deficiency is "based on objective evidence in the prior art references and not on the Examiner's subjective speculation." (See Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed.Cir. 2000)).

The Office Action does not establish a *prima facie* case of obviousness for yet another reason. The Office Action erroneously concludes that "one skilled in the art would obviously recognize that *Bidiville* permits the thumb to actuate or to rest naturally over the ball, while also permitting the index and center fingers to activate a button and the ulnar fingers to wrap around the side of the body and under the body. (Office Action, p. 3). This conclusion is absolutely erroneous.

*Bidiville* in fact prohibits "the ulnar fingers wrapping around the side and under the device." As already noted, with *Bidiville* the fingers purposefully rest on *Bidiville*'s "upper housing" in a pronated position and a "neutral posture." (See discussion above). Therefore, with the *Bidiville* device, quite explicitly, the ulnar fingers are not available to "wrap around the side and under the device," as in Claim 20. Furthermore, the *Bidiville* button and the unoccupied space to the contiguous right of that button, prevent the ring finger and last finger from wrapping around and under the device. (See discussion above). Also, the *Bidiville* ball (*Bidiville*, figure 20E, numeral 710) aligns the fingers to the front of the device, not the side. All this clearly undermines the Office Action's unsupported conclusion that the ulnar fingers could "wrap around the side and under the body" of Claim 20.

Furthermore, even if the ulnar fingers could avoid interference from the button (*Bidiville*, figure 20B, numeral 2020A) and the unoccupied space next to that button, and wrap around and under the *Bidiville* device (which Applicant insists is not possible), the user's thumb would be removed from the ball. (*Bidiville*, Col. 25, lines 5-9, figures 20A-B). Also, the remaining fingers would be removed from the remaining buttons. (*Bidiville*, figures 20A-B). All this runs counter to the requirements of Claim 20.

Therefore, contrary to the Office Action's assertion, *Bidiville*, by its very terms, prohibits the "ulnar fingers from wrapping around and under the device," as claimed in Claim 20. Not only does *Bidiville* fail to teach or suggest "ulnar fingers wrapping around the side and under the device" as alleged by the Office

Action, but *Bidiville* teaches away from using *Jarlance-Huang* as conjured by the Office Action for the reasons stated above. Moreover, the Office Action fails to establish, as it must, that using *Jarlance-Huang* to cure the *Bidiville* deficiency is "based on objective evidence in the prior art references and not on the Examiner's subjective speculation." (See Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 229 F.3d 1120, 1124-25, 56 U.S.P.Q.2d 1456, 1459 (Fed.Cir. 2000)).

The Office Action fails to establish a *prima facie* case also because its conclusion that *Bidiville* is "operable in an environment without a work surface i.e., the trackball is held in the user's hand" is absolutely incorrect for several reasons. (Office Action, p. 4). The *Bidiville* device maintains the user's fingers and thumb at an approximately 30-degree angle, so that it is in a "neutral posture." (*Bidiville*, Col. 25, lines 1-11; figures 20B, 20D). For this reason, *Bidiville*'s "upper housing" is at a 30-degree angle. (*Id.*). However, the *Bidiville* device maintains the 30-degree angle only as long as it is resting on a work surface. (*Bidiville*, figures 20C-D). Furthermore, since the user's fingers rest on *Bidiville*'s "upper housing" and the user's thumb rests on the ball, it is impossible for the user to hold the device in his or hand. (*Bidiville*, Col. 25, l. 1-11; figures 20B, 20D). Finally, since the user's fingers rests on *Bidiville*'s "upper housing," the device must rest on a work surface to resist the weight of naturally placed on the top of the device by the user's hand. (*Id.*). All this undermines the Office

Action's assertion that *Bidiville* can be used in a hand-held manner. (Office Action, p. 4).

As discussed above, this also shows that using *Jarlance-Huang* to cure the *Bidiville* deficiency, as conjured by the Office Action, would run counter to *Bidiville's* purposes and therefore *Bidiville* leads the skilled artisan away from using *Jarlance-Huang* and away from the claimed invention.

Moreover, *Jarlance-Huang* does not teach or suggest its use to cure the *Bidiville* deficiency as conjured by the Office Action. (Office Action, p. 4). The Applicant's device, as claimed in Claim 20, allows for both use of the device while it is resting on a work surface or, alternatively, while it is being held in the user's hand.<sup>1</sup> *Jarlance-Huang*, though, is directed to a device to be used solely while being hand-held.<sup>2</sup> As noted above, *Bidiville* is directed to a device that is used solely on the work surface. Neither reference teaches or suggests any need or desire for a device that can do both, such as the device of Claim 20.

---

<sup>1</sup> Claim 20 states "[a] cursor control device for ergonomic hand-held or work surface use." (See Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 987, 221 U.S.P.Q. 669 (Fed.Cir. 1984)) (the PTO should consider preambular language as part of the scope of the claim and purpose or intended use of the invention). (See also Applicant's specifications, p. 12, lines 1-2; p. 14, lines 9-10; p. 18, lines 14-16).

<sup>2</sup> *Jarlance-Huang* describes itself as a "palm-top" wireless trackball. (*Jarlance-Huang*, Col. 1, lines 4-5). Also, *Jarlance-Huang* only describes use of the device while it is being hand-held. (*Jarlance-Huang*, Col. 2, lines 42-45). Finally, there does not appear to be a way *Jarlance-Huang* could be used while on a work surface.

Furthermore, the Office Action erroneously cites to *Jarlance-Huang's* specification as support for the desirability for the conjured change to *Bidiville*. (Office Action, p. 4). The language relied upon by the Office Action is merely a proclamation of the benefits of the *Jarlance-Huang* device itself, not a motivator to do anything further. (Office Action, p. 4). Indeed, the statement would not motivate one with ordinary skill in the art to look past the teachings of *Jarlance-Huang*, and certainly would not be motivation to apply any aspect of *Jarlance-Huang* to *Bidiville*.

For all the reasons stated above, *Bidiville* alone, and using *Jarlance-Huang* to cure the deficiency of *Bidiville* as conjured by the Office Action, even if possible (which Applicant insists is not), would not meet the requirements of Claim 20. Thus, no *prima facie* case of obviousness has been made. As mentioned above, our patent law requires that the prior art references relied by the Office Action teach or suggest the claimed subject matter in order to support an obviousness rejection. (See *In re Rinehart*, 531 F.2d 1048, 1051, 189 U.S.P.Q. 143, 147 (CCPA 1976); see also, *In re Dembiczak*, 175 F.3d 994, 1000-01, 50 U.S.P.Q.2d 1614, 1617-19 (Fed.Cir. 1999) (for an obviousness rejection to be sustained, the Federal Circuit requires the PTO to make specific findings as to the contents of the prior art which suggest the combination of the references)). No such showing has been made by the patent office.

Finally, the Office Action does not make a *prima facie* case of obviousness because the only reason the Office Action conjured the combination was hindsight knowledge derived from the Applicant's own disclosure. The Office Action is attempting to use these references to simply reconstruct in hindsight Applicant's disclosure. Such a practice is strictly prohibited. "It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious." (See In re Fritch, 972 F.2d 1260, 1266 n. 14, 23 U.S.P.Q.2d 1780, 1783-84 n. 14 (Fed. Cir. 1984)).

The requirement that the motivation for the combination derive from the prior art of record, and not from the Applicant's own disclosure, "is stringently applied so as to "guard[] against entry into the tempting but forbidden zone of hindsight." (See Loctite Corp. v. Ultraseal Ltd., 781 F.2d 861, 873, 228 U.S.P.Q. 90, 98 (Fed. Cir.1985)). "Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.'" (W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983); see also, Para-Ordnance Mfg. V. SGS Importers Int'l, Inc., 73 F.3d 1085, 1087, 37 U.S.P.Q.2d 1237, 1239 (Fed. Cir. 1995)).

The mere fact that *Bidiville* could be modified by *Jarlance-Huang* as suggested by the Office Action (which, as explained elsewhere in this Response,

would still not yield an operable device), does not make the modification "obvious" since there is no suggestion in the prior art to do so and since the only motivation is found in the Applicant's own disclosure. (See In re Fritch, 972 F.2d 1260, 1266 n. 14, 23 U.S.P.Q.2d 1780, 1783-84 n. 14 (Fed. Cir. 1984)). For this reason, the Federal Circuit regularly points out that virtually all inventions are combinations of existing elements. (See Life Technologies, Inc. v. Clontech Laboratories, Inc., 224 F.3d 1320, 13226, 56 U.S.P.Q.2d 1186 (Fed. Cir. 2000). If patentability could be refused merely by demonstrating that each element of an invention is found in the prior art, then very few patents, if any, would be granted. (In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457 (Fed.Cir. 1998)).

With Applicant's disclosure as a template, it appears that the PTO impermissibly set out to reconstruct Applicant's invention by piecing together elements found in the prior art. Since there is an absence of proper motivation for the combination conjured by the Office Action, the Office Action does not make out a *prima facie* case of obviousness under 35 U.S.C. Section 103(a).

Since the prior art references do not teach or suggest the combination conjured by the Office Action, this is yet another reason the Office Action does not establish a *prima facie* case of obviousness. Indeed, "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983).

- c. Even If Proper Motivation Were Established For Using *Jarlance-Huang* to Cure the Deficiency of *Bidiville*, (which Applicant insists it has not been), the Resulting Device Would Not Meet the Demands of Claim 20

Even assuming, *arguendo*, that proper motivation were established to use *Jarlance-Huang* to cure the deficiency of *Bidiville* as conjured by the Office Action (which Applicant insists it has not been) the resulting device would fall short of the specific requirements of Claim 20 for several reasons.

In Claim 20, the "at least one key" aligns the ulnar fingers with the side of the claimed invention so that they can wrap around and under the side to hold in the user's hand. (Claim 20, Figures 2 and 4). As already mentioned, the buttons in *Bidiville*, (*Bidiville*, figures 20A-E, numerals 2020A-C) align the ulnar fingers with the front of the *Bidiville* device. Since the ulnar fingers are aligned to the front of the device, they cannot wrap around the side of the device. Again, this difference is critical because using the ulnar fingers to hold the device at the front (instead of the side) would not be comfortable, or even possible.

The device resulting from the Office Action's conjured combination would fall short of meeting the specific requirements of Claim 20 for another reason. With the claimed invention, the "convex palm surface" specifically allows for the "ulnar fingers to wrap around the side of the body and under the body to hold the device in the user's hand." (Claim 20). *Bidiville*, though, has an "upper housing" to support the user's entire hand. *Bidiville*'s upper housing itself, along with the last button (*Bidiville*, figure 20B, numeral 2020A) and the unoccupied space next to that last button, would interfere, and in fact prevent, the ulnar fingers from "wrapping around the side and under the body to hold the device in the user's



hand," as claimed. (*Bidiville*, Col. 25, lines 1-11; figures 20B and 20E). Moreover, even if those fingers could manage to "wrap around the side and under" the conjured device, the thumb would be removed from the ball and the others fingers would be removed from the buttons, thereby contradicting Claim 20.

The device resulting from the Office Action's conjured combination would fall short of meeting the specific requirements of Claim 20 for a yet another reason. Claim 20 states that the claimed invention is a "cursor control device for ergonomic hand-held or work surface use."<sup>3</sup> (Claim 20). This dual purpose is not possible with *Bidiville*, *Jarlance-Huang* or the fictitious device conjured by the Office Action. Particularly, because the fingers and thumb would rest on the top surface of such a conjured device – as required by *Bidiville* – they could not hold the device in the user's hand.

For all these reasons, even if proper motivation for using *Jarlance-Huang* to cure the deficiency of *Bidiville* were found in the prior art relied upon by the Office Action, which Applicant insists was not, the resulting device would fall short of meeting the specific requirements of Claim 20. Thus, the obviousness rejection cannot be sustained.

---

<sup>3</sup> See footnote 1, above.

d. Even If Proper Motivation Were Established For Using Jarlance-Huang to Cure the Deficiency of Bidiville, the Resulting Device Is Not "Obvious"

Even assuming, *arguendo*, that proper motivation were established to use *Jarlance-Huang* to cure the deficiency of *Bidiville* as conjured by the Office Action (Applicant insists that it was not) doing so would not have been "obvious."

Achieving the device of the pending claims required substantial inventive effort. (See Inventor's Affidavit, paragraphs 5 and 6<sup>4</sup>). Meeting the need for a device that can be used comfortably and ergonomically both on a work surface or, alternatively, while being hand-held, without significant change of hand positions and without the need for any mechanical change, was not easily accomplished. (Id.). This extensive inventive effort rebuts the notion that the device of the pending claims is "obvious."

Indeed, even to arrive at the fictional device conjured by the Office Action (which if real, would not make sense, would not function and would certainly not achieve the ends of the claimed invention) required a tiring exercise of mental gymnastics by the PTO. Moreover, that exercise was entirely based, and impermissibly so, on the teachings of Applicant's own disclosure. Therefore, the device of Claim 20 is unobvious.

---

<sup>4</sup> Applicant insists that the Office Action fails to set forth a *prima facie* case of obviousness, for that reason alone, the obviousness rejection should be withdrawn. If the Examiner agrees, then consideration of the Inventor's Affidavit is not necessary.

2. Claim 21

Claim 21 is dependent on independent Claim 20. Claim 21 states

*The device of Claim 20, further comprising a second key occupying the forward side of the body to be activated by a finger of a hand while the thumb of said hand actuates the roller ball and the ulnar fingers of said hand wrap around the side of the body and under the body to hold the device in said hand.*

Dependent claims are nonobvious under Section 103 if the independent claims from which they depend are nonobvious. (See In re Fine, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596, 1600 (Fed.Cir. 1988)). Since the obviousness rejection as to independent Claim 20 cannot be sustained, it follows that the obviousness rejection as to dependent Claim 21 is likewise unsustainable.

3. Claim 22

Amended Claim 22 as described in Section II(B), above, is identical to Claim 20, except that the ball of Claim 22 is located at the "upper right portion," instead of the "upper left portion," as in Claim 20. Applicant submits that this clarification overcomes the Section 112 rejection. Claim 22 was also rejected under Section 103 as being unpatentable under *Bidiville*, in view of *Jarlance-Huang* and in further view of *Koh*. For all the reasons stated in connection with Claim 20, the invention of Claim 22 is nonobvious and is, in all respects, patentable. For purposes of the obvious analysis as to Claim 22, each and every argument above addressing the *Bidiville* reference are incorporated herein as they are likewise applicable to the *Koh* reference.

4. Claim 23

Claim 23 is dependent on independent Claim 20. Claim 23 claims "[t]he device of Claim 20, further comprising a scroll wheel disposed between the keys." The Office Action rejected Claim 23 on the ground that inclusion of a scroll wheel was obvious based on the prior art of record.

Dependent claims are nonobvious under Section 103 if the independent claims from which they depend are nonobvious. (In re Fine, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596, 1600 (Fed.Cir. 1988)). Since the obviousness rejection as to independent Claim 20 cannot be sustained, it follows that the obviousness rejection as to dependent Claim 23 is likewise unsustainable.

### III. CONCLUSION

It is respectfully submitted that the pending claims embody a distinct advance in the art not rendered obvious by the cited art of record. Accordingly, Applicant respectfully requests that the rejections be withdrawn and a Notice of Allowability be issued. Should the Examiner have any questions regarding this response, the Examiner is invited to telephone the Applicant.

Respectfully submitted this 19<sup>th</sup> day of September, 2002.



David M. Lilienfeld, *pro se*  
Inventor/Applicant

424 Lindbergh Drive  
6 Suite 305  
Atlanta, Georgia 30305  
(404) 262-5622 - telephone  
dmlilienfeld@yahoo.com - electronic mail